

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed July 7, 2006 (the "Office Action"). Applicants respectfully request reconsideration and favorable action in this case.

Section 112 Rejections

The Office Action rejects Claims 1-8, 12-23, and 27-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse these rejections for the reasons stated below.

The prior version of independent Claim 1 included the limitation "wherein the conical portion of the body has a degree of taper; and wherein the plurality of crests define a cone having the same degree of taper as the conical portion of the body." The Office Action rejects this limitation and contends that the Examiner could not find support for the limitation in the specification. Applicants respectfully traverse this rejection. However, Claim 1 has been amended to remove this limitation. In view of the amendment, the rejection of Claim 1 is moot. Applicants request that the rejection of Claim 1 be withdrawn.

Claims 3-8 and 12-16 each depend, either directly or indirectly from Claim 1. Therefore, for at least the reasons discussed above with regard to Claim 1, Applicants respectfully request that the rejections of Claims 3-8 and 12-16 be withdrawn.

Similar to Claim 1, Claims 17 has been amended to remove the limitation rejected by the Office Action. For at least those reasons discussed above with regard to Claim 1, Applicants respectfully request that the rejection of Claim 17 be withdrawn.

Claims 18-23 and 27-33 each depend, either directly or indirectly from Claim 17. Therefore, for at least the reasons discussed above with regard to Claim 1, Applicants respectfully request that the rejections of Claims 18-23 and 27-33 be withdrawn.

Section 102 Rejections

The Office Action rejects Claims 1, 2, 17, and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,360,450 issued to Giannini (“*Giannini*”). Applicants respectfully traverse these rejections for the reasons stated below.

Claim 1 is directed to a medical implant comprising a body including a conical portion having a length, and a plurality of uninterrupted threads formed around an exterior surface of the conical portion of the body and extending along at least a portion of the length of the conical portion. The body is adapted for implantation into a person’s body and sized to fit within a sinus tarsi of a subtalar joint in the person’s body for at least partially preventing displacement of the talus associated with the subtalar joint. The plurality of threads are adapted to help secure the implant in place within the sinus tarsi. Each of the plurality of threads includes a crest having a substantially flat surface. The threads are tapered with respect to a longitudinal axis of the body. *Giannini* does not disclose each of these limitations.

The Office Action suggests that Figure 2 of *Giannini* discloses “a plurality of threads (protrusions between the grooves 11) formed on an exterior surface of the conical portion (see fig.2).” *See Office Action*, page 3. Figure 2 of *Giannini*, however, clearly discloses that the threads are interrupted. For example, in describing Figure 2, *Giannini* states that “shank 16, when screwed inside of hole 6, causes wings 7a and 7b to flex outwards, and is screwed inside hole 6 until wings 7a and 7b are so parted as to contact astragalus 3 and calcaneus 4 and achieve a predetermined position of axis A of astragalus 3 in relation to axis B of calcaneus 4.” *See Giannini*, col. 2, lines 25-30. The parting of wings 7a and 7b causes an interruption of the threads. *See Giannini*, Figure 2. *Giannini* does not disclose the medical implant of Claim 1, for example a plurality of uninterrupted threads formed around an exterior surface of the conical portion of the body and extending along at least a portion of the length of the conical portion. For at least these reasons, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 17 includes limitations related to a plurality of uninterrupted threads formed around an exterior surface of the conical portion of the body

and extending along at least a portion of the length of the conical portion. For at least those reasons discussed above with regard to Claim 1, Applicants respectfully contend that *Giannini* does not disclose each of these limitations. Therefore, Applicants respectfully request that the rejection of Claim 17 be withdrawn.

The Office Action rejects Claims 1, 2, 17, and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,436,139 issued to Shapiro et al. ("*Shapiro*"). Applicants respectfully traverse these rejections for the reasons stated below.

The Office Action suggests that Figure 12 of *Shapiro* discloses "a plurality of threads (512) formed on an exterior surface of the conical portion." See *Office Action*, page 3. Figure 12 of *Shapiro*, however, clearly discloses that the threads are interrupted. For example, in describing Figure 12, *Shapiro* states that "[t]hread 512 is interrupted by thread cut outs 514 and 520 forming barbs 515 and 521, respectively." See *Shapiro*, col. 8, lines 17-19. *Shapiro* does not disclose the medical implant of Claim 1, for example a plurality of uninterrupted threads formed around an exterior surface of the conical portion of the body and extending along at least a portion of the length of the conical portion. For at least these reasons, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 17 includes limitations related to a plurality of uninterrupted threads formed around an exterior surface of the conical portion of the body and extending along at least a portion of the length of the conical portion. For at least those reasons discussed above with regard to Claim 1, Applicants respectfully contend that *Shapiro* does not disclose each of these limitations. Therefore, Applicants respectfully request that the rejection of Claim 17 be withdrawn.

The Office Action rejects Claims 1, 2, 4, 5, 17, 18, 20, and 21 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 2005/0177243 issued to Lepow et al. ("*Lepow*"). Applicants respectfully traverse these rejections for the reasons stated below.

Applicants submit, concurrent with this response, an Affidavit under 37 C.F.R. §1.131 that establishes a date of conception and reduction to practice prior to February 10, 2004.

Therefore, Applicants respectfully submit that *Lepow* may not, alone or in combination, be used to support rejections of any of the pending claims in the Application. Thus, Applicants respectfully request the withdrawal of the rejections of Claims 1, 2, 4, 5, 17, 18, 20, and 21. Furthermore, Applicants respectfully request reconsideration and allowance of all pending claims.

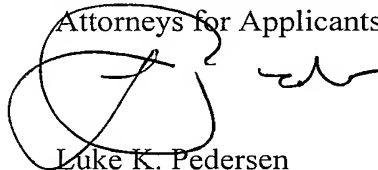
Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is authorized to charge the \$790.00 RCE fee, and to the extent necessary, charge any additional required fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Luke K. Pedersen
Reg. No. 45,003
PHONE: (214) 953-6655

Date: October 9, 2006

CORRESPONDENCE ADDRESS:

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6494

Customer Number: **05073**
Attorney Docket No.: 073275.0163